

Appl. No. 09/555,592
Amdt. Dated May 31, 2005
Reply to Office action of April 6, 2005
Attorney Docket No. P08778-US1
EUS/J/P/05-1141

REMARKS/ARGUMENTS

1.) Claim Amendments

No claims have been amended or cancelled. Claims 15-19 have been added. Accordingly, claims 1-3, 8-9 and 15-19 are now pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections-35 U.S.C. § 112

The Examiner rejected claims 1-3, 8 and 9 as failing to comply with the written description requirement, asserting that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. With regard to claim 1, the Examiner states that "a list of said gateways is stored in the by-pass network . . ." is not supported by the original disclosure. The Applicants traverse the rejection.

First, the subject matter of claim 1 noted by the Examiner previously was within claim 7, which, in the Office Action dated November 14, 2003, the Examiner objected to as being dependent upon a rejected base claim, but stated would be allowable if rewritten in independent form.¹ It is further noted that claim 7 was again indicated as being allowable if rewritten in independent form in the Office Action dated April 5, 2004.² In response to that Office Action, the Applicants amended claim 1 to include the limitations of claim 7. Now, however, the Examiner asserts that the subject matter of claim 7 added to claim 1 is not supported by the original disclosure. The Examiner reads prior claims 6 and 7, together with the specification at page 7, lines 29-30, to support his assertion that the list of gateways in the by-pass network must be stored in an intelligent network (IN) node. The Examiner's assertion is

¹ The Examiner's indication that claim 7 would be allowable stated that it would be allowable if rewritten to "overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims." The Office Action, however, did not set forth any rejections of claim 7 under Section 112.

² In this Office Action, the Examiner also did not state any rejection of claim 7 under Section 112.

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incorrect. Although the specification describes a specific embodiment in which the list of gateways is stored in an IN node, the recitation of that specific embodiment does not render the claimed limitation ("a list of said gateways is stored in the by-pass network") as unsupported by the original application.

Prior claim 7 stated that "there is maintained an updated list of gateways in the by-pass network," which, as those skilled in the art can recognize from the specification, is not necessarily the IN network. The limitation of claim 7 that was added to claim 1 was based on original claim 10 in the PCT priority application (copy included herewith), which stated that: "there is maintained an updated list of gateways in the by-pass network, *i.e.*, the intelligent network (IN), . . ." Thus, the original claims supported an embodiment in which the by-pass network was equivalent to the intelligent network (IN). That equivalence provides the basis for Applicants' claimed limitation that the list of gateways is stored in a by-pass network. Therefore, the Examiner's rejection of claim 1 as failing to comply with the written description requirement should be withdrawn. Whereas claims 2-3 and 8-9 are dependent on claim 1, and include the limitations thereof, the rejection of those should also be withdrawn.

3.) Allowable Subject Matter

The Examiner's rejection of claim 1 is based on his assertion that the disclosure only supports an embodiment in which a list of gateways is stored in the IN network; he raises no other objections or rejections. Claim 15, added herein, corresponds to claim 1 wherein "IN" has been substituted for "by-pass." Accordingly, claim 1 is allowable. Furthermore, whereas claims 16-19³ depend from claim 1, and include the limitations thereof, those claims are also allowable.

³ Claims 16-19 are identical in subject matter to claims 2-3 and 8-9 and, thus, do not constitute new matter.

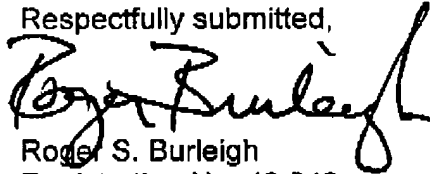
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CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-3, 8-9 and 15-19.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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